

DISCUSSION OF THE AMENDMENT

Claim 1 has been amended by incorporating the subject matter of Claim 3 therein; Claim 3 has been canceled. Claim 1 has been further amended by rearranging the claim steps in their order, and by inserting --in order--; by changing from passive to active voice, where appropriate; and by beginning each step on a new line. Claims 4 and 9 have also been amended by changing from passive to active voice. Claim 11 has been amended by incorporating the subject matter of Claim 13 therein; Claim 13 has been canceled. Claims 14 and 16 have been amended to depend on Claim 11. Finally, Claim 19 has been amended to depend on Claim 11, and by inserting that the first reagent includes the at least one of an aluminum salt and a gallium salt, as supported in the specification at, for example, Example 1.

No new matter is believed to have been added by the above amendment. Claims 1, 2, 4-12, and 14-19 are now pending in the application.

REMARKS

The rejection of Claims 1, 2, 6-8, 10-12, 17 and 19 under 35 U.S.C. § 103(a) as unpatentable over EP 1143244 (Ebinuma) in view of U.S. 5,814,521 (Chapoteau), is respectfully traversed. All of the present claims contain the limitations of Claim 3 or Claim 13, not subject to this rejection. Accordingly, it is respectfully requested that the rejection be withdrawn.

The rejection of Claims 1-19 under 35 U.S.C. § 112, first paragraph, is respectfully traversed. The Examiner finds that the specification does not reasonably provide enablement for any reducing substance, but for quantitatively determining only hydrogen sulfide or sulfide ions.

In reply, the rejection would thus not appear to apply to Claims 6 and 7 which defines the reducing substance. Nor would the rejection appear to apply to Claims 11-19, which are drawn to a reagent *per se*, wherein the term “for quantitative determination of a reducing substance” is a statement of intended use only. Nevertheless, it is clear from the specification that the invention is not limited to particular reducing substances. Indeed, as described in the specification at page 14, second full paragraph, any reducing substance is contemplated so long as it is capable of reducing iron (III) ions. An example listed is ascorbic acid, which is not sulfur-containing. Since Claim 1 necessarily requires that the reducing substance react with iron (III) ions thereby forming iron (II) ions, any reducing substance that is not capable of reducing iron (III) ions is necessarily excluded by the claims.

A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. §112, first paragraph, unless there is a reason to doubt the objective truth of the statement contained therein which must be

relied on for enabling support. The first paragraph of 35 U.S.C. §112 requires nothing more than objective enablement. See *In re Marzocchi*, 439 F. 2d 220, 169 USPQ 367 (CCPA 1971) (**copy enclosed**), and M.P.E.P. 2164.04. The Examiner has set forth **no** reasons why one skilled in the art would doubt the truth of any statement in Applicants' disclosure.

In the absence of prior art, it is manifestly unjust to require such limiting of the claims, since it would invite any would-be pirate to use a reducing substance not specifically disclosed and thereby infringe the claims with impunity. Such a requirement is also contrary to law. *Marzocchi, supra*. The Examiner has not met her burden in showing why objective enablement is not present. It is respectfully requested, therefore, that the rejection under 35 U.S.C. §112, first paragraph, be withdrawn.

The rejection of Claims 1-10 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. The Examiner finds that it is not clear what method steps are involved in the claimed invention. The Examiner asks whether iron ions are added to or contained within the specimen, and is the metal indicator added.

In reply, the specification makes it clear that the iron ions are derived from an iron (III) compound that is part of the reagent. Thus, it is added to the specimen when the claimed method is carried out. The metal indicator is also part of the reagent although, for purposes of the claimed method, may be added subsequently to adding the iron (III) compound.

Accordingly, it is respectfully requested that the rejection be withdrawn.

The objection to Claims 1 and 11, and the dependent claims, is respectfully traversed. Indeed, the objection would now appear to be moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the objection be withdrawn.

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter in Claims 3-5, 9, 13-16 and 18. The present claims contain the limitations of such

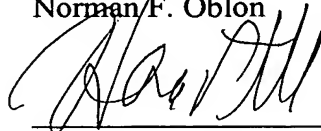
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allowable subject matter. Accordingly, it is respectfully requested that the Examiner pass this application to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Norman F. Oblon



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Harris A. Pitlick

Registration No. 38,779

Customer Number

**22850**

Tel: (703) 413-3000

Fax: (703) 413 -2220

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